

REMARKS/ARGUMENTS

Claims 49-56 are pending in the present application. The amendments made to the specification were objected to for not identifying the page and line numbers of the amended paragraphs. The claims were rejected under 35 U.S.C. §102(f) for allegedly being invented by another. The claims were also rejected under the doctrine of obviousness-type double patenting for allegedly being obvious over the claims of US Patent No. 5,532,220.

Objections to the specification

In the office action, the Examiner requested that amendments to the specification made in the response filed November 17, 2003 should include the page and line number of the beginning of each amended paragraph. Applicants understand, therefore, that the previous amendments to the specification were not entered. The same amendments are presented in this amendment with the requested information.

Rejection under 35 U.S.C. § 102(f)

The claims stand rejected for allegedly being invented by Lee and Chen, who are the inventors on US Patent No. 5,532,220. As noted in the rejection the claims of the '220 patent are directed to treatment of cancer cells lacking wild-type p53 by introducing a wild-type p53 gene into the cells. In the Office Action, the Examiner asserts that the claims of the '220 patent "encompass the methods claimed in the instant invention." Applicants note, however, the claims of the present invention are directed to methods of treating cancer cells lacking endogenous wild-type RB protein by introducing a wild-type RB gene into the cells. Thus, the methods of the two inventions are directed to treating different classes of cancer cells (lacking either wild-type p53 or wild-type RB) and using different tumor suppressor genes (p53 or RB, respectively). Thus, applicants respectfully submit that '220 claims do not encompass the present invention. Since the claims are clearly directed to two different inventions, there is no basis to assert that Lee and Chen are the inventors of the present invention. In the absence of evidence suggesting that the Lee and Chen invented the present invention, the rejection is improper and should be withdrawn.

The claims also stand rejection under 35 U.S.C. § 102(f) for allegedly being the invention of Lee, Huang, Lee, Friedmann and Yee. In order to expedite prosecution, applicants submit with this response a petition to change inventorship under 37 CFR §1.48.

Double Patenting Rejection

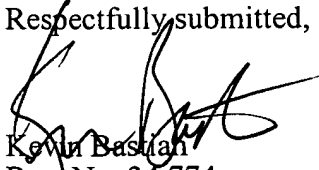
The double patenting rejection of the claims over the claims of the '220 patent are respectfully traversed. As noted above, the claims of the present application are directed to treatment of a different class of cancer cells using a different tumor suppressor gene than that claimed in the '220 patent. In the present rejection, the Examiner asserts that the invention of the '220 patent is a species of the claims in the present application. The basis for this rejection is inconsistent with that stated for the §102(f) rejection discussed above. In that rejection, the Examiner asserts that the present claims are encompassed by the claims of the '220 patent. Clarification is respectfully requested.

In any case, applicants note that the claims of each patent are directed to use of a different tumor suppressor gene to treat a different class of cancer cells. The Examiner has provided no reasoning or evidence to show how use of p53 would lead one of skill to the present invention. In the absence of such a showing the rejection is improper and should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



Kevin Bastian
Reg. No. 34,774

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834

Appl. No. 10/028,726
Amdt. dated July 13, 2004
Reply to Office Action of February 13, 2004

PATENT

Tel: 415-576-0200
Fax: 415-576-0300
Attachments
KLB:klb
60260291 v1